In the Supreme Court of the United States

OCTOBER TERM, 1965

No. 747

HAROLD L. MACK, PETITIONER

v.

COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE COMMISSIONER OF PATENTS IN OPPOSITION

OPINION BELOW

The opinion of the Court of Customs and Patent Appeals (Pet. App. 1-2) is reported at 344 F. 2d 719.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on May 6, 1965. A timely petition for rehearing was denied on June 24, 1965. On September 21, 1965, the Chief Justice extended the

time in which to petition for a writ of certiorari to and including November 21, 1965. The petition for a writ of certiorari was filed on November 16, 1965. The jurisdiction of this Court is invoked under 28 U.S.C. 1256.

QUESTION PRESENTED

Whether the petitioner's claims for a patent covering flavor treatment of cigarette filters was anticipated by the Davidson patent, 21,164,702, issued on July 4, 1939.

STATUTES INVOLVED

35 U.S.C. 102 provides, in pertinent part:

> A person shall be entitled to a patent unless—
>
> * * * *
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent * * *.

35 U.S.C. 103 provides, in pertinent part:

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. * * *

STATEMENT

On July 11, 1960, petitioner filed an application with the Patent Office for a patent to cover "[a] treatment of filters for cigarettes and the like comprising adding several drops of tincture of tobacco flavored to taste to a filter" (Tr. 6).[1] The purpose of petitioner's alleged invention was to restore tobacco flavor to filter cigarettes (Tr. 4). All of the petitioner's claims were rejected by the Examiner on the ground that his claimed invention had been anticipated by the Davidson patent (2,164,702) issued July 4, 1939 (Tr. 17.)[2]

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[1] "Tr." refers to the Transcript of Record in this case filed in the United States Court of Customs and Patent Appeals on January 20, 1964.

[2] The Davidson patent shows a "filter plug" as a cigarette component (Tr. 49, col. 2, 11. 16-19) and provides for flavoring as follows (Tr. 51, col. 2, 11. 27-35):

> Preferably the paper or other material constituting the above-described fillers is so constituted or treated as to be fire resistant or self-extinguishing, and is suitably sized. In addition, the material may be treated by coating or, in the case of soft-sized paper, *saturating the same with an infusion made from tobacco, tobacco stems, cocoa, cinnamon, menthol or other flavoring materials* [emphasis added].

Davidson's "filter plug" seems to be described by his claim 11 (Tr. 52, col. 2, 11. 41-49; Pet. App. 2):

> Paragraph 11. A method of making filter plug mouthpieces for cigarettes, which comprises forming a smoke filter having multitudinous generally longitudinal passages by laterally loosely compressing together, through pressure appied radially inward into substantially cylindrical form, fibrous cellulose material, and simultaneously moving said material in the axial direction of the cylinder so formed.

The Board of Appeals affirmed the decision of the Examiner, stating that "[t]he articles and methods claimed do not appear to us to patently distinguish over Davidson" (Tr. 35). A request for reconsideration was denied by the Board (Tr. 40-41) and the Court of Customs and Patent Appeals affirmed (Pet. App. 1-2).

ARGUMENT[3]

In his patent application, petitioner claimed a treatment by which tobacco essences are added to cigarette filters to compensate for the reduction in tobacco flavor occasioned by the removal of tobacco tars and nicotine from the smoke (Tr. 4, 6). The application was rejected because, in 1939, Davidson was granted a patent for a cigarette "filter plug" which similarly might be treated by coating or saturating it "with an infusion made from tobacco, tobacco stems, cocoa, cinnamon, menthol or other flavoring materials" (Tr. 51). The court below fully met petitioner's argument that the Davidson patent teaches nothing about cigarette filters, but only about non-filter mouthpieces, by quoting Davidson's claim 11 which shows that the Davidson "filter plug" was similar to present cigarette filters.[4]

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[3] There is currently pending before this Court the issue whether certiorari jurisdiction exists under 28 U.S.C. 1256 to review decisions of the Court of Customs and Patent Appeals in patent cases. *Brenner* v. *Manson*, No. 58, October Term, 1965. We urge in that case that such jurisdiction does exist where the criteria for this Court's review are otherwise satisfied.

[4] See fn. 2, *supra*, p. 3.

There is no merit to petitioner's contention that the patentability of his claim over the prior art may not be determined from previous patent claims but only from the specifications of previous patent applications. The entire patent application, including the claims, must be considered in determining what is disclosed. *E.g., Anthony Co.* v. *Perfection Steel Body Co.*, 315 F. 2d 138, 140 (C.A. 6).[5]

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[5] In *In re Downs*, 18 C.C.P.A. (Patents) 803, 807, 45 F. 2d 251, 253, the Court of Customs and Patent Appeals stated a view in accord with petitioner's position, but that "inadvertent" view was modified in *In re Smolak*, 24 C.C.P.A. (Patents) 1132, 1136, 88 F. 2d 838, 841. In that case the court said, "[W]hat we should have said in the case of *In re Charles R. Downs and Augustus E. Craver, supra*, is that 'Anticipation is not to be determined from the precise scope of the claims made in the references, but upon the disclosures in the respective specifications, which, in a reference patent, would include the claims, the written specification, and the drawings." *Ibid.*

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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